

Appl No.: 10/039,695

Atty. Dkt.  
PC-1228**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. This is a supplemental response to amendment response filed February 16, 2004. Applicant has rewritten claims 1, 6, 7, 15, canceled claims 4, 5, 8, 16, 26, 27 and added new claims 28-29. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks. Applicant gratefully appreciates the examiner's statements that claims 8, 12 and 17 contain allowable subject matter. As discussed with the phone conversation with the Examiner on May 6 and May 10, 2004, Applicant did not receive a response to their February filing until May of this year, and therefore requests the supplemental response be entered. Applicant has made a good faith attempt to put the allowable subject matter of dependent claims 8 and 12 into independent form.

Claim 1 has been amended to include the features of former dependent claims 4, 5 and 8. Claim 15 has been amended to include the subject matter of claim 16. New claim 28 is a combination of previous claims 1 and the allowable subject matter of dependent claim 12. And new claim 29 is a combination of previous claims 1, 4, 5 and the allowable subject matter of dependent claim 8.

Claims 1-8, 9, 11, 13-15, 26-27 were stated as being rejected under sec. 102b as being anticipated by Cornwell ('297) in view of Harrell '391. Applicant believes that this statement contains clear typographical errors, since claim 8 was indicated on both page 5 of the office action and on PTO-326 Cover sheet as being objected to for having allowable subject matter. Furthermore, this rejection is believed to be an obvious combination of references and not "anticipated" since the examiner is clearly relying on two references to reject the claims. As such, applicant has responded to this office action

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as understanding that the claims are considered obvious. Furthermore, since claim 16 has not been clearly rejected on page 2 of the office action, both claims 8 and 16 along with dependent claims 12 and 17 would all contain allowable subject matter.

Cornwell '297 describes a "self sealing firestop coupling assembly", title, that clearly requires attaching their assembly to an exterior surface of a boundary as clearly indicated by 12E Fig. 3 with screw fasteners 212E Fig. 6, that must pass through "holes 12F and 212F to allow for securing the coupling assembly 10 and 210 to a concrete form(Fig. 1), as stated in column 6, lines 11-13. The subject invention clearly does not require or use any holes that require mounting fasteners exterior to a concrete type wall. Applicant's claimed invention is to be used inside of a boundary and NOT exterior to a boundary as is required by Cornwell '297. Applicant strongly disagrees with the examiner's characterization that Cornwell '297 "discloses ....a first sleeve 16....a second sleeve 20...(and) a member 12 having a first portion which separates the first sleeve from the second...." Clearly, member 12 as shown in Fig. 3 is EXTERNAL to these so-called sleeves, and does not separate ends of the sleeves as is required by the subject claims. Additionally, component 20 is not "rigid" or a "plastic" as is required by subject independent claims 1, 15 and 29, since Cornwell states that "20" is an "intumescent material" is used as a "fill", which clearly has nothing to do with the claimed "rigid" or "plastic" "sleeves" of the subject claimed invention. Thus, removal of Cornwell is respectfully requested.

Harrell '391 does not overcome the deficiencies to Cornwell described above. Harrell '391 also requires fasteners for fastening to an outside surface of a floor and wall

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and not "inside" of a "boundary" as claimed by the subject invention. Thus, removal of Harrell is respectfully requested.

Applicant strongly disagrees with the statement the "materials of construction have been considered a matter of ordinary skill in the art...." It is clearly improper for the examiner to arbitrarily ignore any of the novel features of any of the claims. Under the rules of the MPEP, if the applicant requests the examiner cite the reference(s) showing each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Under MPEP 706.02 and 37 C.F.R. 1.107(b), applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that the entire invention is obvious under sec. 103. Under the MPEP and CFR sections cited above, the examiner must cite the reference(s) that shows these unsubstantiated opinions and assertions mentioned in their rejection, or remove the 103 rejection for at least these reasons alone.

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination

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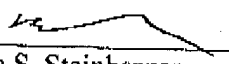
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and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vacck, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims 1-3, 6, 7, 9-15, 17 and 28-29 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1-3, 6, 7, 9-15, 17 and 28-29 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;

  
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